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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,927	03/18/2004	Toshihisa Nakano	2004_0442A	5415
513 7590 01/13/2009 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER				
GEE, JASON KAI YIN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/802,927

**Applicant(s)**

NAKANO ET AL.

**Examiner**

JASON K. GEE

**Art Unit**

2434

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-7,10-16,23 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-7,10-16,23 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/28/2008.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***DETAILED ACTION***

1. This action is response to communication: amendment received 11/28/2008, with acknowledgement of priority date of 03/24/2003.
2. Claims 1, 3, 5-7, 10-16, 23, and 26 are pending in this application.
3. The IDS received 10/29/2008 has been accepted.

***Response to Arguments***

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 25, the claim recites a recording medium. However, the specification indicates that a recording medium may be a transmission medium, such as in paragraphs 25 and claim 2 of the Applicants specification. Mediums such as transmission mediums are directed toward non-statutory subject matter.

As per claim 26, the claim recites a computer program. Claims directed toward a program are non-statutory subject matter and are therefore rejected under 101.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5, 6, 23, and 26 are rejected under 35 U.S.C. 102(e) as anticipated by the Applicants Admitted Prior Art (hereinafter the AAPA), as presented by the applicants Patent Application Publication No. 2004/0190868, in view of Nagashima US patent Application Publication 2001/0029608 (hereinafter Nagashima), and further in view of Hirano et al. US Patent Application Publication 2002/0059522 (hereinafter Hirano).

As per claim 1, the AAPA teaches a recording apparatus for recording a content which is a digital copyrighted work onto a recording medium, comprising: A content obtainment unit operable to obtain a content provide externally (paragraph 13); a recording medium type identification unit operable to identify a type of the recording medium (paragraph 13 and 15); a recording unit operable to record the content onto the recording medium according to one of a plurality of recording copyright protection methods, wherein each of the copyright methods protects a content using at least one of an encryption (paragraph 13, 10, 11, 15) and has a different security level (paragraph 14), and when the type of the recording medium identified by the recording medium type

identification unit is compliant with the plurality of copyright protection methods (paragraphs 14 and 15), the recording unit records the content on the recording medium according to one of the plurality of copyright protection methods having a security level, from the plurality of the copyright protection methods compliant with the recording medium identified by the recording medium type identification unit (paragraphs 14 and 15). However, the AAPA does not teach all the limitations of the claims. These deficiencies are taught by \$\$\$ and \$\$\$

Nagashima teaches a content image quality identification unit operable to identify an image quality of the obtained content (such as paragraphs 37, 449, and 450). Further, Nagashima teaches the use of signatures to protect information (paragraph 19 and 283). Also, it is very well known in the art to be able to identify image quality of obtained content.

Further, Hirano teaches wherein the security level of each of the plurality of copyright protection methods and the image quality of the content are associated with each other such that a higher security level is associated with a higher image quality of the content (Paragraph 144) and wherein the recording unit records the content corresponding to the image quality of the content identified by the content image quality identification (paragraphs 34 and 144)

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of the AAPA with the Nagashima reference. One of ordinary skill in the art would have been motivated to perform such an addition to

account for the differences in image quality for making different decisions (paragraphs 35).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of the AAPA with the Hirano reference. One of ordinary skill in the art would have been motivated to perform such an addition to add convenience to a user by being able to recognize what sort of digital content is contained in data (paragraph 15).

As per claim 3, the AAPA teaches wherein the recording medium type identification unit identifies the type of the recording medium according to a type of information previously stored in a non-rewritable area of the recording medium (paragraphs 5 and 10 -15).

As per claim 5, Hirano teaches a copyright protection method selection unit operable to select the copyright protection method out of the plurality of copyright protection methods based on an instruction from a provider of the content and wherein the recording unit records the content according to the copyright protection method selected by the copyright protection method selection unit (paragraphs 55 and 56, and paragraphs 144-147).

As per claim 6, Hirano teaches wherein the content includes specification information for specifying one copyright protection method out of the plurality of copyright protection methods and the recording apparatus further comprises a

copyright protection method selection unit operable to select the one copyright protection method out of the plurality of copyright protection methods based on the specification information included in the content, wherein the recording unit records the content according to the copyright protection method selected by the copyright protection method selection unit (paragraphs 55, 56, and 144-147.

Independent claim 23 is rejected using the same basis of arguments used to reject claim 1 above.

Independent claim 26 is rejected using the same basis of arguments used to reject claim 1 above.

9. Claims 5-7 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA as applied above, and in view of Sako et al. US Patent Application Publication 2003/0012098 (hereinafter Sako)

As per claim 5, Hirano teaches these limitations of the claims in paragraphs 55 and 56, and also paragraphs 144-147. Also, for further clarification, Sako also teaches such limitations. Sako teaches a copyright protection method selection unit operable to select the copyright protection method out of the plurality of copyright protection methods based on an instruction from a provider of the content and wherein the recording unit records the content according to the copyright protection method selected by the copyright protection method selection unit ( such as in paragraph 97 and throughout the reference)

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the Sako reference with the AAPA. One of ordinary skill in the art would have been motivated to perform such an addition to provide a record medium, a recording method for a record medium, an output controlling method, a reproducing apparatus, a record and reproduction controlling method, a recording method, a recording and reproducing method, and a recording and/or reproducing method that allow a copy operation in a plurality of generations, a reproducing operation, and a charging operation to be easily managed. (Sako paragraph 10).

As per claim 6, Hirano teaches these limitations in paragraphs 55, 56, and 144-147. Sako also teaches wherein the content includes specification information for specifying one copyright protection method out of the plurality of wherein protection methods and the recording apparatus further comprises a copyright protection method selection unit operable to select the one copyright protection method out of the plurality of copyright protection methods based on the specification information included in the content, wherein the recording unit records the content according to the copyright protection method selected by the copyright protection method selection unit (paragraphs 97, 100, and Figure 3).

As per claim 7, Sako teaches wherein the recording method selection unit further selects said one recording method out of the plurality of recording methods based on an instruction by a user, wherein the recording unit records the content according to the



copyright protection method selected by the copyright protection method selection unit (paragraph 159).

As per claim 10, Sako teaches wherein the content obtainment unit includes a plurality of input channel units, each corresponding to a type of data to be obtained, and the recording method selection unit further selects said one recording method out of the plurality of recording methods and recording to which one of the plurality of the input channel units has obtained the content (paragraphs 57, 58, 83, 84, 85, 91, 92, and AIPA paragraph 13).

As per claim 11, Sako teaches wherein the recording unit records a second content by a second recording method on the recording medium while retaining a first content, when the first content is recorded on the recording medium by a first recording method, the second content is the same as the first content, and the second copyright protection method is different from the first copyright protection method; and the second copyright protection method is a copyright protection method having a security level corresponding to the image quality of the content from the plurality of copyright protection methods compliant with the type of the recording medium identified by the recording medium type identification unit (Figures 3, 7, paragraphs 109-116, and throughout the other reference).

As per claim 12, Sako teaches wherein a first content is recorded onto the recording medium by a first recording method, and the recording apparatus further records the first content by a second recording method onto the recording medium after reading out the first content from the recording medium (paragraphs 109-118), and the

second copyright protection method is a copyright protection method of a security level corresponding to the image quality of the content from the plurality of copyright protection methods complaint with the type of the recording medium identified by the recording medium type identification unit (taught throughout the other references)

As per claim 13, Sako teaches wherein the recording method selection unit selects two or more recording methods out of the plurality of recording methods and the recording unit records the content onto the recording medium according to the selected two or more recording methods (paragraphs 197-198 and throughout reference; also AAPA paragraphs 13-16).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA combination as applied above, and in view of Andreaux et al. US Patent Application Publication 2003/0051153 (hereinafter Andreaux)

As per claim 14, the AAPA does not explicitly teach all the limitations of the claims. However, these are taught throughout Andreaux. Andreaux teaches wherein the content obtainment unit encrypts the obtained content according to the one of the plurality of copyright protection methods, and sends the encrypted content to the recording unit via a transmission channel; the recording unit records the encrypted content received via the transmission channel onto the recording medium, thereby the

recording unit records the content onto the recording medium according to the one of the plurality of copyright protection methods. (throughout the reference, such as in the abstract, paragraphs 15-19, 53-54).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the AAPA and the Andreaux references. One of ordinary skill in the art would have been motivated to perform such an addition to increase the flexibility to add encryption accordingly and would also increase the security as well (paragraph 31 of Andreaux).

11. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the AAPA and Andreaux as applied above, and further in view of Nagai US Patent Application Publication 2002/0015494 (hereinafter Nagai)..

As per claim 15, Andreaux teaches wherein the recording method includes a first recording method and a second recording method compliant with the method for protecting a copyright of a content (paragraphs 73-86 and also AAPA paragraph 13). Andreaux further teaches wherein the content obtainment unit encrypts the content with a previously held secret key when the recording unit adopts the first recording method (paragraphs 78 and 86). Nagai further teaches wherein an encryption is made with an externally obtained secret key when the recording unit adopts the second recording method (paragraphs 63-65).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to combine the teachings of Nagai with the AAPA combination. One of ordinary

skill in the art would have been motivated to perform such an addition to increase the security while maintaining low costs (paragraphs 18 and 19 of Nagai).

As per claim 16, Andreaux teaches wherein the recording method includes a first recording method and a second recording method compliant with the method for protecting a copyright of a content (paragraphs 73-86 and also AAPA paragraph 13). Nagai further teaches wherein the content obtainment unit reencrypts the content into an encrypted content corresponding to the second recording method and sends the reencrypted content to the recording unit when the obtained content is an encrypted content corresponding to the first recording method (paragraphs 62-65).

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON K. GEE whose telephone number is (571)272-6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on (571) 272-38113811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Gee  
Patent Examiner  
Technology Center 2400  
01/12/2009

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434

